

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re: Gregory S. Kelley Confirmation No.: 8007
Serial No.: 10/820,659 Examiner: Christopher Koharski
Filing Date: April 8, 2004 Group Art Unit: 3763
Docket No.: 1001.1755101 Customer No.: 28075
For: MEDICAL DEVICES INCLUDING AERATED ADHESIVE BONDS AND
METHODS OF FORMING THE SAME

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

CERTIFICATE FOR ELECTRONIC TRANSMISSION:

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 20th day of August 2008.

By Kathleen L. Boekley
Kathleen L. Boekley

Dear Sir:

Pursuant to 37 C.F.R. § 41.41, Appellants hereby submit this Reply Brief in furtherance of the Appeal Brief filed on April 7, 2008 and the Examiner's Answer mailed June 20, 2008.

REMARKS

Rejection of claims 1-4 and 7 under 35 U.S.C. § 102(e) over Deniega et al.

Independent claim 1 recites, in part, “an aerated adhesive layer positioned between the inner engagement portion and the outer engagement portion”; emphasis added. Deniega et al. fail to teach such an element. On page 9 of the Examiner’s Answer, the Examiner is asserting that in order for the specification to provide a definition of a term used in the claims, the words, “only, must, or specifically” must be used. Appellant respectfully disagrees. Appellant is not aware of any specific language requirement in order for a specification to define a term used in the claims.

In the Appeal Brief, at page 7, Appellant challenged the Examiner’s apparent taking of Official Notice that any adhesive would be “aerated” and would have voids, and requested the Examiner provide documentary evidence of this supposedly well known fact. In the Examiner’s Answer, at page 9, the Examiner again asserted that “during the bonding process it is known that air bubbles are present during manufacture”, but has again failed to provide any documentary evidence supporting the assertion. Further, the Examiner asserts, on page 10 of the Examiner’s Answer, that the characteristics of resisting delamination, absorbing stress, and comprising distensible regions are well known common characteristics of adhesive glues. The Examiner has not provided any support for this assertion and thus appears to be taking Official Notice. Appellant submits that the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. Pursuant to MPEP 2144.04(C), Appellant respectfully traverses the taking of Official Notice and again requests the Examiner provide documentary evidence supporting the rejection. Appellant submits that if the facts asserted by the Examiner were actually capable of instant and unquestionable demonstration as being well-known, documentary evidence would be readily available. As the Examiner has apparently not been able to provide such evidence, the Examiner’s assertions regarding characteristics of adhesives are unsupported. Appellant submits the Examiner’s unsupported assertions regarding inherent properties of the adhesives of Deniega et al. are insufficient to show that the asserted characteristics are necessarily present in Deniega et al. The Examiner’s assertions are thus insufficient to support the anticipation rejection. It appears the Examiner may be considering that the adhesive of Deniega et al. could be modified to be aerated, which is not a proper basis for an anticipation rejection. Deniega et al. fail to teach each and every element of independent claim 1 and thus cannot be deemed to anticipate the claim.

Rejection of claims 9-12 under 35 U.S.C. § 103(a) over Deniega et al. in view of Jauchen et al.

The Examiner asserts that Deniega et al. and the secondary references are analogous in the field of endeavor of medical devices (bandages, catheter optical fiber) and the adhesives used to secure and manufacture them, thus one of ordinary skill in the art would apply the adhesive bonding techniques of all medical devices in order to attain the best possible bond between medical device components while maintaining a safe, effective, biocompatible device. The Examiner appears to be addressing the rejection based on Deniega et al. and Jauchen et al. as this was the only rejection involving a non-analogous art argument by Appellant. The Examiner has not further addressed the rejection of claims 5, 6, 8, 13-18. Appellant reasserts the arguments found on pages 9-11 and 13-15 of the Appeal Brief.

Regarding the rejection based on Deniega et al. and Jauchen et al., Appellant submits that while Deniega et al. and Jauchen et al. may both be considered medical devices involving adhesives, there is no motivation for one of ordinary skill in the art to combine their teachings because each reference is directed to significantly different properties of the adhesive. Further, Deniega et al. are directed to a catheter for use within the body (paragraph 0005), while Jauchen et al. are directed to a self-adhesive bandage for application on the outside of the body (column 3, line 64 through column 4, line 7). Jauchen et al. specifically teach their adhesive as providing “very open-pored adhesive foam layers which are of particularly good permeability to air and water vapour” (column 2, lines 22-24). Appellant submits that one of ordinary skill in the art would understand that the characteristics of such an adhesive for use outside the body are not pertinent to the field of Deniega et al. or the claimed devices, which involve bonding medical device components together, where the device components are used within the human body. Further, the adhesive of Jauchen et al. is not pertinent to the claimed devices, which involve an adhesive that resists stresses caused by adhesive curing. Appellant therefore respectfully submits that it is improper to rely on Jauchen et al. as a reference under 35 U.S.C. § 103.

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007). The Examiner asserts that it would have been obvious to apply adhesive bonding techniques to all medical devices to attain the best possible bond. Appellant disagrees and

submits that modifying the internal catheter Deniega et al. to use the external, air- and water-permeable adhesive of Jauchen et al. would not have been predictable to one of ordinary skill in the art. Jauchen et al. teach their air and water permeable adhesive for providing good skin compatibility and a cushioned effect, which are desirable properties for external bandages. Jauchen et al. are directed to providing an adhesive bond between a bandage and human skin, which is why the air and water permeability of the adhesive is desired. Further, nowhere in Jauchen et al. or Deniega et al. is it suggested that an adhesive that improves joining a bandage with skin would be functional or desirable in the catheter of Deniega et al. Appellant therefore respectfully submits that there is no motivation to combine the references and, consequently, that there is no *prima facie* case of obviousness. For at least this reason, Appellant respectfully submits that the rejection of claims 9-12 is improper.

For the reasons stated above, the rejections of claims 1-18 under 35 U.S.C. §§ 102(e) and 103(a) should be reversed.

Respectfully submitted,

Gregory S. Kelley

By his attorney,



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